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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,460	04/22/2004	Michael Ioelovich	P-6768-US	6428

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EXAMINER

WHITE, EVERETT NMN

ART UNIT PAPER NUMBER

1623

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/829,460

Applicant(s)

IOELOVICH ET AL.

Examiner

Everett White

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendment filed February 16, 2006 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claims 1, 4-6, 8, 9, 12, 14-16, 18-23 and 25 have been amended;
  - (B) Comments regarding Office Action have been provided drawn to:
    - (I) claims objection, which have been withdrawn;
    - (II) 112, 2<sup>nd</sup> paragraph rejections, which have been withdrawn;
    - (III) 102(b) rejection, which has been maintained for the reasons of record;
    - (IV) 103(a) rejection, which has been maintained for the reasons of record.
2. Claims 1-25 are pending in the case.
3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

### **Objection To New Matter Added To Specification**

4. The amendment filed February 16, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment to the second full paragraph on page 6 filed February 16, 2006, includes the addition of the text "formula  $(\text{CH}_3)_3\text{SiO}-[(\text{CH}_3)_2\text{SiO}]_x-[\text{CH}_3\text{RSiO}]_y-\text{Si}(\text{CH}_3)_3$  wherein R is  $(\text{CH}_3)_3\text{O}(\text{C}_2\text{H}_4\text{O})_n(\text{C}_3\text{H}_6\text{O})_m\text{H}$ ".

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Election By Original Presentation***

5. Newly submitted Claim 25 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Previously filed Claim 25, which was drawn to a microcrystalline cellulose product is distinct from the currently amended Claim 25, which appears to be drawn to a composition comprising the microcrystalline cellulose and at least one functional precipitate. A product

Art Unit: 1623

comprising one component is obviously different from a composition comprising the same component along with at least one other component.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claim 25 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections – USC § 112, First Paragraph***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for the term “functional” in Claim 1, line 7 was not located in the instant specification. Hence, the term sets forth new matter, which is improper under 35 U.S.C. 112, first paragraph.

Also, the amendment to Claim 4 which includes a description of the formula  $(\text{CH}_3)_3\text{SiO}-[(\text{CH}_3)_2\text{SiO}]_x-[\text{CH}_3\text{RSiO}]_y-\text{Si}(\text{CH}_3)_3$  wherein R is  $(\text{CH}_3)_3\text{O}(\text{C}_2\text{H}_4\text{O})_n(\text{C}_3\text{H}_6\text{O})_m\text{H}$  is not supported in the instant specification. This lack of support of the formula in the specification classifies the formula as new matter, which is improper under 35 U.S.C. 112, first paragraph.

8. Applicant's arguments with respect to Claims 1 and 4 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112, Second Paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 3, 5 and 6, the metes and bounds of the term "non-ionic wetting agent" cannot be determined which renders the claims indefinite. Applicants only have support for the compound "polyalkylenoxide polysiloxane" as a non-ionic wetting agent. The "non-ionic wetting agent" in Claims 3, 5 and 6 should be limited to "polyalkylenoxide polysiloxane".

In Claim 4, the description of the formula disclosed therein is incomplete because the symbols x, y, n and m have not been defined, which renders Claim 4 indefinite.

11. Applicant's arguments with respect to Claims 3-6 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 102***

12. Claim 25 (previously filed) stand rejected under 35 U.S.C. 102(b) as being anticipated by McGinley et al (US Patent No. 5,462,761) for the reasons disclosed on page 3 of the Office Action mailed November 30, 2005.

13. Claim 25 (previously filed) stand rejected under 35 U.S.C. 102(e) as being anticipated by Schaible et al (Pub. No. US 2003/0089465) for the reasons disclosed on page 3 of the Office Action mailed November 30, 2005.

14. Applicant's arguments filed February 16, 2006 have been fully considered but they are not persuasive. Applicants amended Claim 25 to include the microcrystalline cellulose product and at least one functional precipitate and argue that this combination of ingredients is not disclosed in the McGinley et al patent or the Schaible et al publication. Since Claim 25 and the instant specification do not clarify what compounds are classified as functional precipitate, a detail comparison of Claim 25 with the McGinley et al patent and the Schaible et al publication would be difficult, from the examiner's perspective. Since "functional precipitate" has been rejected under the first

paragraph of 35 U.S.C. 112 as being new matter, the rejection of Claim 25 (previously filed) under 35 U.S.C. 102(b) and 102(e) as being anticipated by the McGinley et al patent and the Schaible et al publication is maintained for the reasons of record.

***Claim Rejections - 35 USC § 103***

15. Claims 1-3 and 7-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schaible et al (Pub. No. US 2003/0089465) in view of McGinley et al (US Patent No. 5,462,761) for the reasons disclosed on pages 4-6 of the Office Action mailed November 30, 2005.

16. Applicant's arguments filed February 16, 2006 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that one skilled in the art would not recognize the compounds used for bleaching disclosed in the Schaible et al patent as functional precipitators during a neutralization reaction. This argument is not persuasive since products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

Applicants argue that the McGinley et al patent does not teach modifiers being generated by a precipitation reaction, which can be combined with microcrystalline cellulose. This argument is not persuasive because no claim was noted wherein a modifier was generated by a precipitation reaction. However, the admixing of at least one modifier is noted in Claim 1. The McGinley et al patent does show that the addition of a fat/emulsifying blend to a microcrystalline cellulose containing slurry is known in the art. See column 7, lines 22 and 23 wherein a fat/emulsifier blend is added to a MCC/konjac slurry and mixed. See instant Claim 17 wherein the modifier thereof may be selected as emulsifiers, which is embraced by the McGinley et al patent. Accordingly, the rejection of Claims 1-3 and 7-24 under 35 U.S.C. 103(a) as being unpatentable over the Schaible et al publication in view of the McGinley et al patent is maintained for the reasons of record.

***Summary***

17. Claims 1-25 are rejected.

***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Examiner's Telephone Number, Fax Number, and Other Information***

19. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Art Unit: 1623

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



E. White



Shaojia A. Jiang  
Supervisory Primary Examiner  
**Technology Center 1600**